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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/091,027

03/06/2002

Kazuo Kuroda

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09/13/2006

SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

DANG, HUNG Q

ART UNIT

PAPER NUMBER

2633

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/091,027	<b>Applicant(s)</b> KURODA, KAZUO	
	<b>Examiner</b> Hung Q. Dang	<b>Art Unit</b> 2633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date. <u>05/14/2002</u> , <u>01/30/2004</u> , <u>08/27/2004</u> , <u>06/27/2005</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Information Disclosure Statement

The information disclosure statement filed 03/06/2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. A copy of a translated abstract of the document designated as "JP 2000-216988" was not supplied by applicants. The reference number provided locates the document without a translated abstract.

### Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites "the table", which has never been mentioned earlier in the context making the scope of the invention indefinite and the claim failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

### Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

*This is a 112, 1st issue*  
*These are grounds of rejection.*  
*The reasons supporting the grounds is a lack of antecedent basis - use A*  
*7-34-05*

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 29-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 29-34 are drawn to "program" as the applicants disclosed in the specification as "readable software program" (see page 34). However, it appears that such would reasonably be interpreted by one of ordinary skill in the art as software, per se. Claims 35-40 are drawn to "signal embodied in a carrier wave", which would reasonably be interpreted by one of ordinary skill in the art as electro-magnetic wave. These subject matters are not limited to that which fall within a statutory category of invention because they are not limited to a process, machine, manufacture, or a composition of matter. Software and electro-magnetic signals do not fall within a statutory category since they are clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogino et al. (US Patent 6,430,291).

Claims 1 and 14 recite a duplication controlling method for controlling duplication by embedding an electronic watermark and a recording medium having an electronic watermark indicating control information regarding duplication into contents comprising

digital information, wherein the electronic watermark includes change position information indicating a change position of contents of the control information.

Ogino et al. anticipate a duplication controlling method for controlling duplication by embedding an electronic watermark and a recording medium having an electronic watermark (column 9, lines 30-40) indicating control information regarding duplication into contents comprising digital information (column 14, lines 43-48), wherein the electronic watermark includes change position information indicating a change position of contents of the control information (column 6, lines 36-56).

Claim 7 recites a duplication controlling apparatus for controlling duplication by embedding an electronic watermark indicating control information regarding duplication into contents comprising digital information, comprising: (1) an embedding device for embedding the electronic watermark into the contents, wherein: (2) the electronic watermark contains change position information indicating a change position where the contents of the control information are changed.

Ogino et al. anticipate a duplication controlling apparatus for controlling duplication by embedding an electronic watermark indicating control information, comprising: (1) an embedding device for embedding the electronic watermark into the contents (column 6, lines 36-56), wherein: (2) the electronic watermark contains change position information indicating a change position where the contents of the control information are changed (column 6, lines 36-56).

Claim 20 recites a duplication controlling apparatus ("system controller" in Fig. 2) for performing control in accordance with duplication-related control information

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embedded in contents comprising digital information, comprising: (1) an electronic watermark reading device for reading an electronic watermark; (2) a change position detection device for detecting a change position of the control information; and (3) a control device for modifying the processing of the duplication controlling apparatus when the change position is detected by the change position detection device, wherein: (4) the electronic watermark contains change position information indicating a change position of contents of the control information.

Ogino et al. anticipate a duplication controlling apparatus for performing control in accordance with duplication-related control information embedded in contents comprising digital information (column 3, lines 37-40), comprising: (1) an electronic watermark reading device for reading an electronic watermark ("duplication inhibition information detection" in Fig. 3; column 7, lines 21-25); (2) a change position detection device for detecting a change position of the control information ("duplication inhibition information detection" in Fig. 3; column 10, lines 53-55); and (3) a control device for modifying the processing of the duplication controlling apparatus when the change position is detected by the change position detection device ("erasing control section" in Fig. 2; column 10, lines 53-67), wherein: (4) the electronic watermark contains change position information indicating a change position of contents of the control information (column 6, lines 36-56).

Claim 25 recites the electronic watermark to contain contents information indicating the contents of the control information, which is started from the change

position, and the control device modifies the processing in accordance with the contents information contained in the electronic watermark.

Ogino et al. anticipate the electronic watermark to contain contents information indicating the contents of the control information, which is started from the change position (column 10, lines 34-40), and the control device modifies the processing in accordance with the contents information contained in the electronic watermark (column 12, lines 55-59).

Claim 26, 27, and 28 recite a reproduction device, a recording device, and a reception device being controlled by the control device.

Ogino et al. anticipate a reproduction device ("recording/playback mechanical deck section" in Fig. 2), a recording device ("recording/playback mechanical deck section" in Fig. 2), and a reception device ("recording/playback signal processing section" and "anti-duplication control signal detection section" in Fig. 2; column 5, lines 27-32) being controlled by the control device ("system controller" in Fig. 2).

Claims 29 and 35 recite a program embodied on a computer-readable medium and a computer data signal for causing a computer to execute an embedding processing of an electronic watermark indicating duplication-related control information into contents comprising digital information, the program causing the computer to function as: (1) an inserting device and step for inserting change position information indicating a change position of contents of the control information into the electronic watermark; and (2) an embedding device and step for embedding the watermark into the contents.

Ogino et al. anticipate a method, an apparatus to execute an embedding processing of an electronic watermark indicating duplication-related control information into contents comprising digital information (column 3, lines 37-40), and to function as: (1) an inserting device for inserting change position information indicating a change position of contents of the control information into the electronic watermark (column 9, lines 30-40); and (2) an embedding device for embedding the watermark into the contents (column 9, lines 30-40).

Hence, Ogino et al. anticipate a program embodied on a computer-readable medium and a computer data signal for causing a computer to perform such functions.

Claims 2-4, 8-10, 15-17, 21-22, 30-32, 36-38 recite the change position information indicating an end and start position of the contents in which the electronic watermark is embedded, and indicating a position where the contents of the control information indicated by the electronic watermark containing this change position change to the subsequent contents.

Ogino et al. anticipate the change position information indicating an end and start position of the contents in which the electronic watermark is embedded (column 6, lines 36-56), and indicating a position where the contents of the control information indicated by the electronic watermark containing this change position change to the subsequent contents (column 6, lines 36-56; column 10, lines 22-35).

Claims 5-6, 11-12, 18-19, 23-24, 33-34, and 39-40 recite a plurality of change positions recorded as a table, and the table to contain contents information indicating



the contents of the control information, which are started from a plurality of the change positions.

Ogino et al. anticipate a plurality of change positions, which include a start address position and an end address position, each of which is recorded as an entry to a table (column 6, lines 36-56), and the table to contain contents information indicating the contents of the control information, which is itself, which is started from the start address (column 6, lines 36-56).

Claim 13 recites a delivery device for delivering the contents having the electronic watermark embedded by the embedding device.

Ogino et al. anticipate a recording medium, which is the delivery device, for delivering the contents having the electronic watermark embedded by the embedding device (column 4, lines 54-61).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Q. Dang whose telephone number is 571-270-1116. The examiner can normally be reached on M-Th:7:30-5:00; every other Friday: 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on 571-272-0898. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Hung Dang*  
*HD*

Hung Dang  
Patent Examiner

*Shanon A. Foley*  
**SHANON A. FOLEY**  
**SUPERVISORY PATENT EXAMINER**